BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/750,302
Filing Date: December 29, 2000
Appellant(s): ROUSE ET AL.

D. Benjamin Esplin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/10/06 appealing from the Office action

mailed 01/04/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1 – 20 have been canceled.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

GROUNDS OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. The rejection of claims 21 – 40 under obviousness-type double patenting with respect to claims 1 – 28 of U.S. Patent No. 7,142,883.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 21 – 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 28 of U.S. Patent No. 7,142,883 (U.S. Pat. Application No. 09/885,139). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim language of the present Application (claims 21 – 40 of 09/750,302) is a broad version of the claims of U.S. Patent No. 7,142,883 (claims 1 - 28).

Claim 21 in the present Application is a broad version of claim 1 in 7,142,883.

Claim 22 in the present Application maps exactly to claim 4 in '883.

Claim 23 in the present Application maps closely to claim 5 in '883.

Claim 24 in the present Application maps very closely to claim 7 in '883.

Claim 25 in the present Application maps closely to a portion of claim 1 in '883 (claim 1 "generating a mobile design element based on the accessed form …").

Claims 26 – 40 are mapped similarly to the explanation given above.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 21 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by

Kahan et al. (U.S. Pat. Pub. No. 2002/0024536) (Method and Apparatus for Information

Aggregation and Personalized Display of the Aggregated Information).

4.1   Regarding claim 21, Kahan discloses a method of formatting content for display

on a mobile wireless client device that is based on a form that is used to display content

on a desktop computer, the form being associated with an action that is executable by

an application, wherein the form is stored remotely from the mobile wireless client

device, the method comprising:

displaying an action menu on the wireless client device, the action menu

including a plurality of action options (Figs. 5, 7, 8; paragraphs 51, 53; paragraph 70

(see below) "Should the subscriber select one of the specific actions associated with a

content item");

paragraph 70 of Kahan

The control process 22 also supports _subscriber manipulations_. For a **content item** that has a

specific action menu associated with it, when the subscriber selects the content item, the subscriber will

view the detailed data attached to the content item (associating a content item with a generic menu or a

specific action menu will be described below). In addition, the subscriber will receive a list of specific

actions as proscribed by the outside applications. The control process 22 builds a screen of **content**

items to present to the subscriber using the data items transmitted (i.e., pushed) from the outside

applications. Should the **subscriber select one of the specific actions associated with a content**

item, the control process 22 transmits the selected action to an application link that actually handles the

selected action (e.g., sell a particular stock) without any further involvement from the control process 22.

enabling selection of the action from the action menu displayed on the mobile

wireless client device (Figs. 5, 7, 8; paragraphs 51, 53; paragraph 70 (see above));

receiving, via a wireless medium, the selection of the action from the mobile

wireless client device (Abstract; Figs. 6, 8; paragraph 70 (see above); paragraphs 51,

53, 115, 116);

executing the action remotely from the mobile wireless client device, wherein

executing the action generates content (Fig. 4, item 22; paragraph 70 (see above));

providing a mobile design element that corresponds to the form and is associated

with the mobile wireless client device (Abstract; Fig. 6; Figs. 3, 4; paragraph 70 (see

above); paragraphs 71 – 78 (see below));

paragraphs 71 – 78 of Kahan

If a generic menu is associated with the selected content item, the control process 22 presents the

identical set of generic actions to the subscriber. Recall that the subscriber interfaces with the control

process 22 through the WML pages 28 or the HTMLXL pages 29 located on the web server 27. At a minimum, the control process 22 supports the following generic actions:

1. Forward--the **subscriber selects this action** to forward a content item to a name entered in a personal address book or entered from the mobile terminal.

2. Keep, Delete--the **subscriber selects one of these actions** to temporarily remove a content item from the mobile portal home page (delete), or to keep it there (keep).

3. Push to Top, Remove, Modify this Line--the **subscriber selects one of these actions** to permanently modify the appearance (i.e., content item positioning) of the mobile portal home page.

4. Voice--the **subscriber selects this action** to execute a text to speech conversion of the content item's text.

5. Go to Application--The **subscriber selects this action** to execute an outside application.

6. Go to Home Page--The **subscriber selects this action** to return to the mobile portal home page.

The foregoing list of generic actions is exemplary in nature and should not be interpreted as limiting in any way.

formatting the content according to the mobile design element (Abstract (see below); Fig. 3; paragraph 14 (see below));

Abstract of Kahan

A method and apparatus for aggregating data items to be sent to a mobile terminal subscriber. A plurality of data items are received from content providers and a subscriber provisioning profile is used to select out desired data items for display on a mobile terminal or a client terminal. **The subscriber provisioning profile contains the mobile terminal subscriber's preferences with regard to the data items, and the data items are formatted for display according to the mobile terminal subscriber's provisioning profile**. The formatted data items are transmitted to the mobile terminal subscriber's terminal for viewing by the subscriber.

Paragraphs 14 of Kahan

According to a fifth aspect of the present invention, a mobile portal server that aggregates content to be transmitted to a terminal subscriber is provided. The **mobile portal server comprises a subscriber database that stores a provisioning profile for the terminal subscribers, and an applications interface processor that receives data items from one or more outside applications and adapts the data items into formatted data items for transmission to mobile terminals** or client terminals associated with the terminal subscribers. The data items are formatted according to a provisioning profile stored on the subscriber database. The mobile portal server further comprises a web server that provides access to the formatted data items, and a control processor connected to the applications interface processor, the subscriber database and the web server.

transmitting the content that is formatted according to the mobile design element to the mobile wireless client device (Abstract (see above); Figs. 3, 4; paragraph 14 (see above)); and

storing the mobile design element remotely from the mobile wireless client device in an application digest (Fig. 3, items 25 and 44; paragraph 14 (see above), paragraph 58 (see below), paragraph 66).

Paragraph 58 of Kahan

For example, a financial services application executing on an applications server at a brokerage house could provide data items regarding the current value of a brokerage account, stock prices, bond prices, interest rates, currency exchange information and other financial information. **If a subscriber was interested in receiving certain data items from the set of data items provided by the financial services application, those selected data items are entered into the subscriber's provisioning profile 44, which is stored on the subscriber database 25.** Of course, the subscriber's provisioning

profile 44 can include requests for data items from a variety of outside applications servers 17-19 (e.g.,

world news items, sports news, weather updates, personal email server, personal calendar, etc.). There is

no limitation on the variety or type of data items that can be listed in a subscriber provisioning profile 44.

4.2   Per claim 22, Kahan teaches the method of claim 21, therein the mobile design

element comprises at least one of a document style sheet, a view style sheet, a pre-

formatted page, and a script (Figs. 5, 7; paragraphs 52, 59).

4.3   Regarding claim 23, Kahan discloses the method of claim 21, further comprising

customizing the form according to settings selected on the wireless client device

(Abstract; Fig. 6, item 62; paragraphs 51, 53).

4.4   Per claim 24, Kahan teaches the method of claim 21, further comprising

customizing the form based on at least one of a date/time setting, a language setting, a

field size setting, a content size setting, and a mobile design element size setting

(paragraph 52).

4.5   Regarding claim 25, Kahan discloses the method of claim 21, further comprising:

generating the mobile design element based on the form (Abstract; paragraph

115).

4.6   Per claims 26 – 40, the rejection of claims 21 – 25 under 35 USC 102(e)

(paragraphs 4.1 – 4.5 above) applies fully.

5.   Claims 21 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by

Kikinis (U.S. Pat. No. 6,076,109) (Simplified-File Hyper Text Protocol).

5.1   Regarding claim 21, Kikinis discloses a method of formatting content for display

on a mobile wireless client device that is based on a form that is used to display content

on a desktop computer, the form being associated with an action that is executable by

an application, wherein the form is stored remotely from the mobile wireless client

device, the method comprising:

        displaying an action menu on the wireless client device, the action menu

including a plurality of action options (Fig. 2; col. 6, lines 48 – 59; col. 9, lines 26 – 41

"menu selections", "the user makes the necessary inputs to establish the provider

connections");

        enabling selection of the action from the action menu displayed on the mobile

wireless client device (col. 6, lines 48 – 59; col. 9, lines 26 - 41);

        receiving, via a wireless medium, the selection of the action from the mobile

wireless client device (Abstract; Fig. 3; col. 6, lines 48 – 59; col. 9, lines 26 - 41);

        executing the action remotely from the mobile wireless client device, wherein

executing the action generates content (Abstract; Figs. 2 – 4; col. 10, lines 36 – 45);

        providing a mobile design element that corresponds to the form and is associated

with the mobile wireless client device (Abstract; Figs. 2 – 4; col. 9, lines 55 – 58 "At step

61 the **user logs on by entering a user name and password** and the field unit

identifies itself with its ID."; col. 10, lines 5 – 36 "Proxy-Server converts all of the .jpg

files to a dithered bitmap format according to information associated with the **user ID**

received from the hand-held at log-on. **This ID establishes the size and resolution**

of the hand-held's display, for example, and the bitmap created from the .jpg files

is scaled to the hand-held's display.");

formatting the content according to the mobile design element (Abstract; Figs. 3,

4; col. 10, lines 5 – 36 "Proxy-Server converts all of the .jpg files to a dithered bitmap

format according to information associated with the **user ID received from the hand-**

held at log-on. **This ID establishes the size and resolution of the hand-held's**

display, for example, and the bitmap created from the .jpg files is scaled to the

hand-held's display.");

transmitting the content that is formatted according to the mobile design element

to the mobile wireless client device (Abstract; Figs. 3, 4; col. 10, lines 37 – 46 "the proxy

server assembles all of these files into a single HT-Lite (HTL) file for **transfer to the**

hand-held"); and

storing the mobile design element remotely from the mobile wireless client device

in a application digest (Abstract; Figs. 3, 4; col. 10, lines 31 – 36; col. 9, lines 7 - 41).

5.2   Per claim 22, Kikinis teaches the method of claim 21, therein the mobile design

element comprises at least one of a document style sheet, a view style sheet, a pre-

formatted page, and a **script** (col. 9, lines 7 - 13).

5.3   Regarding claim 23, Kikinis discloses the method of claim 21, further comprising

customizing the form according to settings selected on the wireless client device (Figs.

3, 4; col. 9, lines 55 – 58; col. 10, lines 30 – 35).

5.4   Per claim 24, Kikinis teaches the method of claim 21, further comprising

customizing the form based on at least one of a date/time setting, a language setting, a

field size setting, a content size setting, and a mobile design element size setting (Fig.

3, item 101; col. 10, lines 30 - 35).

5.5   Regarding claim 25, Kikinis discloses the method of claim 21, further comprising:

       generating the mobile design element based on the form (Figs. 3, 4; col. 9, lines

55 – 58; col. 10, lines 30 – 35).

5.6   Per claims 26 – 40, the rejection of claims 21 – 25 under 35 USC 102(e)

(paragraphs 5.1 – 5.5 above) applies fully.

(10) Response to Argument

With regard to the rejection of claims 21 – 40 under obviousness-type double patenting

with respect to claims 1 – 28 of U.S. Patent No. 7,142,883:

Applicant has presented no arguments.

With regard to the rejection of claims 21 - 40 under 35 USC 102(e) with respect to

Kahan et al. (U.S. Pat. Pub. No. 2002/0024536):

Applicant states that Kahan does not disclose the feature "providing a mobile design

element that corresponds to the form and is associated with the mobile wireless client

device" (p. 13, paragraph 2).

Examiner disagrees.

Kahan clearly discloses providing a mobile design element that corresponds to the **form**

and is associated with the mobile wireless client device (Abstract; Fig. 6; Figs. 3, 4;

paragraphs 70 – 78 (see above)).

The generic action menu of Figure 6 (and corresponding paragraphs 70 – 78) of Kahan

shows a "form" as defined in the claim language.

In the specification of the present Application (hereafter Rouse; paragraph 71 shown

below), Rouse clearly teaches that "**varying fields may be supported in a form** …

such as rich text, … **checkbox**, and other fields."

As seen in Figure 6 of Kahan, and discussed in paragraphs 70 – 78 of Kahan, a

checkbox scenario is disclosed as a "form", wherein a mobile design element

corresponds to the form (paragraph 70 of Kahan "the control process 22 also **supports**

subscriber manipulations … the **subscriber will receive a list of specific actions**

as proscribed by the outside applications.")

Therefore Kahan does disclose providing a mobile design element that corresponds to

the **form** and is associated with the mobile wireless client device

Paragraph 71 of Rouse (U.S. Pat. Pub. No. 2002/0103908; p.23, paragraph 2 of the specification for

the present Application)

Varying fields may be supported in a form or subform, such as rich text, text, date/time, number,

checkbox, radio button, listbox, authors, names, readers and other fields. Rich text fields may be treated

as simple text fields when sent to a mobile device where the text may be used and any embedded objects

may be ignored or otherwise suppressed. However, attachments and other objects may be addressed.

For example, when an attachment appears in a rich text field, a text replacement string may be

substituted for the attachment in the text stream sent to the mobile device. Rich text fields in a wireless

access application may also be assigned a truncation property, where a predetermined number of bytes

of field (or number of characters) contents may be sent to the mobile device.

Applicant states that "the subscriber provisioning profile of Kahan appears to be used

for formatting content for display on a mobile terminal according to predetermined

settings." (p. 15 of arguments).

Examiner disagrees.

Kahan clearly teaches "profiles set by the subscriber" (see paragraph 51 below) that

formats content for display on a mobile terminal used by the subscriber.

Paragraph 51 of Kahan

The present invention provides selected information in a personalized format as requested by the

subscriber, and the personalized format is dynamically updated according to presentation rules

(described below) and **profiles set by the subscriber.** The present invention provides the subscriber

with much easier and immediate access to desired information through aggregation of information from

applications according to the presentation rules. The present invention allows the subscriber to use a

conventional pull menu driven user interface as well.

Applicant states that "claims 23, 28, 33, and 38 include the feature of customizing the

form according to settings selected on the mobile wireless client device" and that Kahan

does not teach this feature.

Examiner disagrees.

Kahan clearly discloses customizing the form according to settings selected on the

mobile wireless client device (Figs. 5, 7, 8, Fig. 6, items 61, 62; paragraph 92 "The sort

by line selection 61 allows the subscriber to change the display position of the selected

data items on the mobile display terminal. The change profile selection 62 allows the

subscriber to change the profile of selected data items …"; paragraph 70 (see above);

paragraph 59).

With regard to the rejection of claims 21 - 40 under 35 USC 102(e) with respect to

Kikinis (U.S. Pat. No. 6,076,109):

Applicant argues that Kikinis does not disclose a "mobile wireless client device 'based

on a form that is used to display content on a desktop computer'" (p. 8, paragraph 1);

and "providing a mobile design element that corresponds to the form and is associated

with the mobile wireless client device." (p. 8, paragraph 2).

Examiner disagrees.

Kikinis clearly teaches "mobile wireless client device 'based on a form that is used to

display content on a desktop computer'" and "providing a mobile design element that

corresponds to the form and is associated with the mobile wireless client device."

As taught in the rejection above, Kikinis discloses a user ID entered by the user (col. 9, lines 55 – 58) and sent to the Proxy-Server, wherein this ID "establishes the size and resolution of the hand-held's display ..." (col. 10, lines 30 – 35).

Applicant argues that Kikinis does not disclose "customizing the form according to settings selected on the wireless client device." (p. 10, paragraph 4).

Examiner disagrees.

Kikinis discloses a user ID entered by the user (col. 9, lines 55 – 58) and sent to the Proxy-Server, wherein this ID "establishes the size and resolution of the hand-held's display ..." (col. 10, lines 30 – 35). The settings are automatically selected when the user enters the ID, thereby customizing any forms since the ID "establishes the size and resolution of the hand-held's display ...".

Applicant argues that Kikinis does not include the feature of "generating the mobile design element based on the form." (p. 10, paragraph 2).

Examiner disagrees.

Kikinis discloses a user ID entered by the user (col. 9, lines 55 – 58) and sent to the Proxy-Server, wherein this ID "establishes the size and resolution of the hand-held's display ..." (col. 10, lines 30 – 35). The act of the user entering the ID automatically establishes the size and resolution of the hand-held display.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kenneth R. Coulter

Conferees:

Rupal Dharia